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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/331,261	07/13/99	PEREGRINO FERREIRA	P 41823

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HM22/0228

EXAMINER

ZEMAN, R

ART UNIT	PAPER NUMBER
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1645

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DATE MAILED:

02/28/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/331,261

Applicant(s)

Ferreira et al

Examiner

Robert A. Zeman

Group Art Unit

1645



☒ Responsive to communication(s) filed on Jun 18, 1999

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-3 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-3 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 1645

DETAILED ACTION

The Group and/or Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group Art Unit 1645.

Response to Amendment

Amendment filed on 1/21/2000 is acknowledged. Claims 1-3 were amended.

Claims 1-3 are pending and under consideration.

Priority

Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Brazil on 12/18/96. It is noted, however, that applicant has not filed a certified copy of the priority application as required by 35 U.S.C. 119(b). It is noted that the copy of the foreign priority document has not been forwarded by the International Bureau. Applicant is requested to provide a copy of said document. Applicant has stated that a certified copy has been requested. To date, no certified copy has been received.

Objections to Specification

The objection to the disclosure is withdrawn in light of the amendments thereto.

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Claim Objections

The objection to claim 1 is withdrawn in light of the amendments thereto.

Claim Rejections Withdrawn

The rejection of Claims 1-3 under U.S.C. 112 first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention is withdrawn. Applicant's arguments have been considered and found persuasive.

The rejections of Claims 1 and 2 under U.S.C. 112 second paragraph, as being indefinite are withdrawn in light of the amendments to the claims.

Claim Rejections Maintained and New Grounds of Rejections:

Claim 3 is rejected under U.S.C. 112 second paragraph, as being indefinite for reciting improper Markush language and for being confusing. Applicant's use of commas and semicolons is inconsistent making it impossible to determine what groupings Applicant is claiming. Use of the "... from group consisting of polystyrene or polypropylene microtiter wells; polyethylene, polypropylene, polycarbonate, polyvinyl, polystyrene or glass test tubes, capillary tubes, dipsticks, or beads; latex beads; nitrocellulose; nylon; cellulose; polyacrylamide; cross-linked

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dextran and microcrystalline glass.” is suggested. Applicant’s amendment has been considered and has been deemed insufficient to overcome the rejection.

The rejection of Claims 1-3 under 35 U.S.C. 103(a) as being unpatentable over Peterson et al. (U.S. Patent 5,427,907) in view of Reis et al. (Reis et al, 1996 GENBANK ACC. NO. U53453) and Ball et al. (Journal of Virology, 1992 Vol. 66 pp. 732-742) is maintained. Applicant’s argues it would not have been “obvious to try” a recombinant gp 90 in the process of Peterson et al. and that Peterson et al. teaches away from the use of synthetic gp45 in immunoassays. These arguments have been considered and are not deemed to be persuasive.

Applicant cites Peterson et al. (column 11, lines 1-6) as evidence that Peterson et al teaches away from the use of synthetic gp90 in immunoassays. Peterson et al do not state that the gp90 molecule as a whole is unsuitable for a immunoassay due to antigenic variability but that peptides **within** the gp90 are unsuitable for use in immunoassays.

With regard to applicants argument that it would not have been “obvious to try” a recombinant gp90 protein in the methods of Peterson et al., absolute predictability is not required but merely a “reasonable” expectation of success. Applicant claims the use of a recombinant gp90 in a conventional immunoassay. As Applicant has pointed out on page 6 of his amendment “ the skilled artisan would have no difficulty in making recombinant gp 90” and that “those skilled in the art well know how to make the material necessary for practice of the present method” The use of recombinant proteins in conventional assays is common practice and hence

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would have been obvious to one of skill in the art. Additionally, the aforementioned rejections are based on the combination of references not only Peterson et al.

Conclusion

No Claim is allowed.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert A. Zeman whose telephone number is (703) 308-7991. The examiner can be reached between the hours of 7:30 am and 4:00 pm Monday through Friday.

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If attempts to reach the examiner by telephone are unsuccessful, Donna Wortman, Primary Examiner can be reached at (703) 308-1032 or the examiner's supervisor, Anthony Caputa, can be reached at (703)308-3995.

Robert A. Zeman

February 25, 2000


DONNA WORTMAN
PRIMARY EXAMINER